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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112740-1051

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Signature _____

Typed or printed name _____

Application Number

10/522,345

Filed

March 10, 2005

First Named Inventor

Mark Beckmann

Art Unit

2617

Examiner

Nimesh Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 48,196
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

December 17, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".

☒ Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Mark Beckmann
Appl. No.: 10/522,345
Conf. No.: 6320
Filed: March 10, 2005
Title: METHOD AND DATA SYSTEM FOR CONNECTING A WIRELESS LOCAL
NETWORK TO A UMTS TERMINAL STATION
Art Unit: 2617
Examiner: Nimesh Patel
Docket No.: 112740-1051

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated September 17, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 16-30 are pending in the present application.. Independent claims 16, 27 and 30 are the focus of the present request.

Claims 16-30 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action argued that the term “polling specific subscriber data of the wireless local network for the logical connection” is indefinite, since it was allegedly unclear to the Office what the phrase meant, and further argued that the claim was “open ended.”

Applicant submits that the claims are definite and particularly point out and distinctly claim the subject matter of the invention. Applicant cannot find any basis under MPEP 706.03(d) to which the present rejection is based upon. Applicant believes the meaning and scope of the claimed terminology is clear from a basic reading of the claim language, which will not be repeated for the purposes of this request. Regarding the “open ended” argument, Applicant can only find support for such a rejection in MPEP 2173.05(c) which relates to “numerical ranges and amount limitations” - Applicant has not provided any “numerical ranges” or “amounts” in the claims at issue. Additional support for the claimed terminology may be found, for example, in paragraphs [0013-15] of the amended specification. Applicant earnestly requests this rejection be reversed.

Claims 16, 17, 19, 23, 24, 26 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Reddy (US Pub 2004/0043791), in view of Lin (US Patent 6,078,811). Claims 20-22 and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Reddy (US Pub 2004/0043791), in view of Lin (US Patent 6,078,811), and further in view of 3GPP TS 31.111 version 4.5.0, release 4.

Specifically, the cited art, alone or in combination, fails to teach or suggest the features of “monitoring activity of the wireless local network by the terminal station using an existing connection; transmitting at least one of a type and an identity number of the wireless local network to the terminal station following successful detection of local network activity; initiating a logical connection between the wireless local network and the terminal station; and polling

specific subscriber data of the wireless local network for the logical connection" as recited in claim 16, and similarly recited in claims 23 and 30.

As argued previously, Reddy discloses a mobile unit, wherein a removable storage module (SIM) has a unique storage module identity for storing information specific to a user, including an Internet Protocol (IP) address, a Public Land Mobile Network (PLMN), and International Mobile Subscriber Identity (IMSI) ([0030]). Reddy teaches that, upon successfully camping on a cell of a mobile network, an IP address is forwarded to an IP-based network capable of communicating with the mobile unit ([0032]). Alternately, the mobile unit has multi-network capabilities which allow it to communicate with an IP-based network and a cellular network at the same time ([0031]).

Under Reddy, the mobile unit does not monitor activity of the wireless local network using an existing connection as presently claimed. Instead, the mobile unit facilitates a cell search, and camps on the cell determined from the search ([0027]). It is clear from the disclosure that "searching" for a cell node is not equivalent to "monitoring activity of the wireless local network by the terminal station using an existing connection." To be sure, the search is conducted *because* the phone has no existing connection at the time of the search. Furthermore, to be able to "monitor" something, it has to exist (i.e. be recognized) in the first place.

Applicant cannot find where in Reddy it is disclosed that at least one of a type and an identity number of the wireless local network is transmitted to the terminal station following successful detection of local network activity. The Office Action alleges that the mere recitation of "system information" encompasses *all* information, including the type and identity number of a wireless local network (page 2, second paragraph: "inherently discloses"). However, Applicant respectfully submits such examination is improper, as the specific kind of "system information" is not disclosed in Reddy. Furthermore, the reception of the "system information" in Reddy is disclosed as being transmitted from a node within a Radio Network Controller (RNC) (FIG. 1 (S3B), 6 (S22B), and 7 (S29B)) which is not considered a wireless local network. In FIG. 5, an "all-IP" network is disclosed, where the mobile unit connects to an IP network using the physical layer to set up the connection [0032: "provided the mobile unit is able to access the IP network at the physical layer"]. However, since the connection is occurring

in the physical layer directly to an IP network, there is no "type" or "identity number" of a wireless local network that is transmitted at this point, since the IP address would have to be known to the user before the connection is even attempted.

Moreover, Reddy fails to teach or suggest the feature of initiating a logical connection between the wireless local network and the terminal station. The Office Action claims that the mobile unit connects to the Core Network 125 through UTRAN node 120 or with an IP address (page 7). However, this position confuses the *multiple different networks being connected by the mobile unit*. The UMTS core is certainly not a wireless local network. Reddy also fails to teach or suggest the feature of polling specific subscriber data of the wireless local network for the logical connection.

Lin fails to solve the deficiencies of Reddy, discussed above. Lin deals with the problem of "overflow" mobile terminals (i.e., more mobile terminals than user records that can be maintained at the visitor location registers) (see col. 5, lines 11-12). The process in steps S6.1-6.6 deals with the registration procedure for a telephone moving between registration areas (RA; see col. 6, lines 13-17). Under Lin, the described process deals with HLR information that is stored in the HLR for visitor location registers (VLR) for "overflow" terminals during registration (col. 6, lines 39-65). Thus an "existing connection" cannot be had until the registration is completed (col. 6, lines 13-18; col. 7, lines 4-11).

Additionally, there is no apparent reason why one having ordinary skill in the art would combine the references in the manner suggested in the Office Action. As argued above, Reddy teaches that, once a device has successfully camped on a cell of a mobile network, an IP address is forwarded to an IP-based network capable of communicating with the mobile unit ([0032]), or the mobile unit has multi-network capabilities which allow it to communicate with an IP-based network and a cellular network at the same time ([0031]). Again, Reddy, does not disclose that the mobile unit monitors activity of the wireless local network using an existing connection, and instead, the mobile unit facilitates a cell search, and camps on the cell determined from the search ([0027]). In contrast, Reddy discloses the updating of HLR databases for VLR's when devices are moving between registration areas. The Office Action fails to reconcile how the VLR's and "overflow" terminals would conceivably be utilized under the configuration of Reddy, which does not appear to utilize VLR's at all.

For at least these reasons, Appellant respectfully submits the rejections are improper and should be reversed. In light of the above, Appellant respectfully submit that independent claims 16, 27 and 30, and all claims depending directly or indirectly therefrom, are allowable. Appellants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-1051.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

BY 

Peter Zura
Reg. No. 48,196
Customer No.: 29177
Phone: (312) 807-4208

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